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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,835	10/19/2001	Alex S. Taylor	110914	7065

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EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,835

Applicant(s)

TAYLOR ET AL.

Examiner

Laurie Ries

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to communications: amendment, filed 10 February 2005, to the original application, filed 19 October 2001.

Claims 1-7 and 9-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovchinsky.

Claims 8 and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovchinsky and Evans (U.S. Patent 6,363,179 B1).

New claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovchinsky.

Claims 1-19 are pending. Claims 1, 9 and 19 are independent claims. Claims 18-19 are new claims.

Claim Rejections - 35 USC § 103

Claims 1-7 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovchinsky.

As per claims 1-2 and 9-11, Price discloses a system and method of processing at least two documents, including a source document and a target document (See

Price, Page 33, Column 2, paragraphs 4-5, and Page 34, Column 1, paragraph 1) including a search device for searching the target document to identify whether any words of interest are present in the target document (See Price, Page 34, Column 1, paragraph 3), and an annotation device for annotating the words located in the target document (See Price, Page 34, Figure 5). Price also discloses that the documents are pre-selected by a user of the system. Note that "pre-select" is defined as "to select beforehand, usually according to a specific criterion" (See The American Heritage Dictionary of the English Language, Fourth Edition, as cited by www.dictionary.com). Price discloses that all documents are stored on local disk or, in another implementation, on a remote database. In either case, the criterion for pre-selection of the documents in the collection of Price is the set of documents existing in the collection of documents loaded into the local disk or remote database. As such, this is a finite set of documents pre-selected by a user of the system, i.e., the pre-selection of the document collection that he or she is using the system to access and manipulate (See Price, Page 36, Column 1, paragraphs 2 and 5). Price does not disclose expressly detecting one or more annotated regions in a source document, and inputting and storing a number of words of interest, each of the words stored as a result of being annotated in the source document. Golovchinsky discloses retaining the selection of an instance of a word on a page where the word is stored as a result of an annotation, such as being highlighted by a user (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are

analogous art because they are from the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often users select each word to obtain the invention as specified in claims 1-2 and 9-11.

As per claims 3 and 12, Price and Golovchinsky disclose the limitations of claims 2 and 10 as described above. Price also discloses including a capture device for optically capturing a digital image of a physical source document (See Price, Page 35, Column 2, paragraph 6).

As per claims 4 and 13, Price and Golovchinsky disclose the limitations of claims 3 and 11 as described above. Price also discloses detecting annotations in a captured image of the source document (See Price, Page 34, Column 1, paragraphs 2-3).

As per claims 5 and 14, Price and Golovchinsky disclose the limitations of claims 4 and 13 as described above. Price also discloses detecting a type of annotation (See Price, Page 34, Column 1, paragraph 2).

As per claims 6 and 15, Price and Golovchinsky disclose the limitations of claims 5 and 14 as described above. Price also discloses that the type of annotation detected

includes one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring (See Price, Page 34, Column 1, paragraph 2).

As per claims 7 and 16, Price and Golovchinsky disclose the limitations of claims 1 and 9 as described above. Price also discloses optically capturing a digital image of a physical target document to be annotated (See Price, Page 35, Column 2, paragraph 6).

Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovchinsky as applied to claims 1 and 9 above, and further in view of Evans (U.S. Patent 6,363,179 B1).

As per claims 8 and 17, Price and Golovchinsky disclose the limitations of claims 1 and 9 as described above. Price and Golovchinsky do not disclose expressly that the annotating includes annotating one or more words in the target document using the same type of annotation as used in a source document from which the stored words are derived. Evans discloses highlighting the text in a second document that corresponds to the highlighted text in a first document. (See Evans, Column 2, lines 1-14). Price, Golovchinsky and Evans are analogous art because they are from the same field of endeavor of processing digital documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the highlighting annotations of Evans with the source and target documents of Price and Golovchinsky. The motivation for doing so would have been to display in a visually distinct manner a region of the second document image that corresponds to the matching word in the first document so that the user may more easily identify a matched search term. (See

Evans, Column 2, lines 15-18). Therefore, it would have been obvious to combine Evans with Price and Golovchinsky for the benefit of easily identifying matching terms in a first and second document to obtain the invention as specified in claims 8 and 17.

As per claim 18, Price and Golovchinsky disclose the limitations of claim 9 as described above. Price also discloses that the method is implemented by a set of program instructions stored in a storage medium and executable on a data processing device (See Price, Page 30, "Abstract").

As per claim 19, Price discloses a device implemented method of processing at least two documents including inputting a source document (See Price, Page 35, Column 2, paragraph 6, and Page 36, Column 1, paragraphs 1-2), inputting a target document, the target document pre-selected by a user of the device (See Price, Page 36, Column 1, paragraph 5). Price does not disclose expressly annotating the source document to identify a number of words of interest and storing the words of interest. Golovchinsky discloses retaining the selection of an instance of a word on a page where the word is stored as a result of an annotation, such as being highlighted by a user (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are analogous art because they are from the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would

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have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often users select each word to obtain the invention as specified in claim 19.

Response to Arguments

With regard to claims 1 and 9, Applicant states on page 6 of the amendment, filed 10 February 2005, that each document that is returned by the search is unknown to the user prior to the search and thus cannot be pre-selected. The Office respectfully disagrees. Note that "pre-select" is defined as "to select beforehand, usually according to a specific criterion" (See The American Heritage Dictionary of the English Language, Fourth Edition, as cited by www.dictionary.com). Price teaches that all documents in the XLibris system are stored on local disk or, in another implementation, on a remote database. In either case, the criterion for pre-selection of the documents of Price is, specifically, the documents existing in the collection of documents loaded into the local disk or remote database. As such, this is a finite set of documents pre-selected by a user of the system, i.e., the pre-selection is document collection that he or she is using the XLibris system to access and manipulate (See Price, Page 36, Column 1, paragraphs 2 and 5).

With regard to claims 8 and 17, in response to applicant's argument that Evans does not disclose "using the same type of annotation", the test for obviousness is not

whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Also with regard to claims 8 and 17, and in addition to the disclosure of Evans addressing the limitations presented in claims 8 and 17, Price also suggests incorporation of these limitations in the disclosed XLibris system, specifically, that the annotation device is operable to annotate one or more words in the target document using the same type of annotation as used in the source document from which the words in the storage device are derived. Price discloses that a user may use "ink anchors" to link to other documents. On page 35, column 1, first paragraph under the section labeled "Ink Anchors", Price discloses that a user may circle any mark which converts that mark into an anchor. Further down column 1, also on page 35, under the section labeled "Presentation", Price discloses producing a list of clippings that contain matching target ink anchors. Price references Figure 6, presented on page 35, Column 2. Note in Figure 6 an annotation, or ink anchor, made up of a circle around the handwritten word "pages". Note that Figure 6 shows this ink anchor attached to the word "Page" in four target documents. Price's disclosure of a user circling a mark, such as a handwritten word, and the system further propagating this annotation, or ink anchor, in its same form, to target documents, as shown in Figure 6, further illustrates the limitations of claims 8 and 17.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached at (571) 272-4090.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have

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questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER